

REMARKS

Claims 1, 3 and 5-8 have been rejected under 35 U.S.C. 102(e) as being anticipated by Gattani. Dependent claims 2 and 10 have been rejected under 35 U.S.C. 103 as being unpatentable over Gattani in view of Dutkiewicz. Dependent claim 9 has been rejected under 35 U.S.C. 103 as being unpatentable over Gattani.

This rejection is respectfully traversed for the following reasons.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). When imposing a rejection under 35 U.S.C. § 102 for lack of novelty, the Examiner is required to specifically identify wherein an applied reference is asserted to identically disclose each and every feature of a claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there are significant differences between the claimed apparatus and method vis-à-vis those disclosed by Gattani that scotch the factual determination that Gattani discloses an apparatus and method identically corresponding to those claimed.

In particular, claim 1 recites a method of configuring a transceiver having an output driver for driving an output terminal to provide data transmission via residential twisted pair wiring, the method comprising the steps of:

setting a DC level at the output terminal for supplying a transmit signal of a prescribed level to the residential twisted pair wiring,

comparing a controlled value representing the DC level with a predetermined threshold level, and

controlling the output driver until the controlled value is equal to the threshold level.

Independent claim 5, as amended, recites a transceiver for providing data communications over residential twisted pair wiring, comprising:

- an output driver having an output for supplying a transmit signal of a prescribed level to the residential twisted pair wiring, and

- an output drive control system for comparing a DC level set at the output of the output driver with a predetermined threshold signal to control the output driver so as to maintain the transmit signal at the prescribed level.

The Examiner relies upon multiple portions of Gattani for disclosing the steps of claim 1 and elements of claim 5. However, none of the relied upon portions of the reference discloses the steps and elements identically corresponding to those claimed.

It appears that the Examiner realizes that Gattani does not provide a disclosure identically corresponding to the claimed subject matter because the Examiner's conclusion of anticipation is based on her interpretation of analog-to-digital converter (ADC) disclosed by Gattani that "**effectively** compares a value representing the DC level with a threshold in order to sample the analog signal and convert it to a digital value."

It is respectfully reminded that the claimed subject matter does not involve sampling the analog signal and converting it to a digital value. Therefore, even according to the Examiner's interpretation, Gattani does not identically disclose the claimed invention.

Considering the reference, Gattani discloses a DSL system having a transceiver 120 (FIG. 1) for transmitting and receiving data to and from the medium 160 via an analog front end 130. As shown in FIG. 2, the front end comprises a digital-to-analog converter (DAC) 215 for converting **transmit** data and an analog-to-digital converter (ADC) 260 for converting **receive** data.

Accordingly, an ADC that “effectively compares a value representing the DC level with a threshold in order to sample the analog signal and convert it to a digital value” is used by Gattani on a **receive** end for converting **receive** data.

Accordingly, even following the Examiner’s interpretation, Gattani does not disclose comparing a controlled value representing the DC level (set at the output terminal **for supplying a transmit signal** of a prescribed level to the residential twisted pair wiring) with a predetermined threshold.

It is noted that the Examiner considers the oversampled ADC 402 to correspond to the claimed output driver control system. As shown in FIG. 4, the ADC 402 is supplied with a signal provided from a DAC 302, which in turns receives signals from an output of a Delta-Sigma modulator 300.

As disclosed in the reference, the Delata-Sigma modulator 300 is an element of the DAC 215. The output of the ADC 402 is used for controlling nonlinear correction of the Delta-Sigma modulator 300.

Accordingly, the ADC 402 provides no reason to conclude that it performs the claimed comparison of a controlled value representing the DC level (set at the output terminal for supplying a transmit signal of a prescribed level to the residential twisted pair wiring) with a predetermined threshold.

Furthermore, the Gattani system does not control the output driver until the controlled value is equal to **the threshold level used by the ADC 402 for sampling**.

Accordingly, Gattani cannot disclose the step of controlling the output driver until the controlled value is equal to the threshold level, as claim 1 requires.

In addition, the ADC 402 of Gattani does not compare a DC level set at the output of the output driver with a predetermined threshold signal to control the output driver so as to maintain the transmit signal (supplied to the residential twisted pair wiring) at a prescribed level, as claim 5 recites. It is reminded that the output of the ADC 402 is used for controlling nonlinear correction of the Delta-Sigma modulator 300, not for maintaining the transmit signal at a prescribed level.

Finally, it is respectfully submitted that in the event the Examiner relied upon inherency without expressly indicating such reliance, the Examiner should be aware that inherency requires certainty, not speculation. *In re Rijckaert*, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

However, as discussed above, one skilled in the art would have no reason to conclude that the claimed subject matter is necessarily present in the Gattani system.

Accordingly, Gattani neither expressly nor inherently discloses the subject matter of independent claims 1 and 5.

Further, it is submitted that Gattani neither alone nor in combination with Dutkiewicz teaches or suggests the subject matter of the dependent claims 2-4 and 6-10. Moreover, these claims are defined over the prior art at least for the reasons provided above in connection with the respective independent claims.

In view of the foregoing, and in summary, claims 1-10 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Alexander V. Yampolsky
Registration No. 36,324

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AVY:apr
Facsimile: 202.756.8087
Date: March 14, 2007

**Please recognize our Customer No. 20277
as our correspondence address.**